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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



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Application No.: 10/660,358

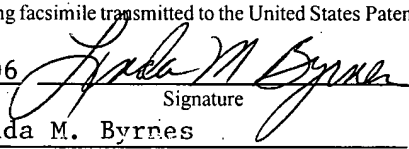
Group: 1626

Filed: September 11, 2003

Examiner: Anderson, Rebecca L.

Confirmation No.: 5512

For: Synthesis of Indolizines

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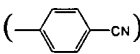
REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply is in response to the Restriction Requirement dated December 6, 2005.

Responsive to the Restriction Requirement for an election of one of two groups, Applicants hereby elect Group I, **with traverse** with respect to Groups I and II, for the reasons set forth in detail below.

Also, for search purposes only, Applicants elect a compound of Structural Formula IIa, where ring A is phenyl, R0 is -H; R3 is -H; X is -C(O)-; and R1 is 4-cyanyl phenyl () among the recited compounds that are prepared by the method of Claim 1. Further, among the recited precursors for preparing the elected compound above, Applicants elect, for search purposes only, a compound of Structural Formula IVa where R0 is -H; X is -C(O)-; and R1 is 4-cyanyl phenyl. Claims which read on these species are, for example, Claims 1-30.

Summary of the Restriction Requirement

The Examiner considered that the claims of the present application claim two patentably distinct inventions, and restricted the claims into two groups: Group I for Claims 1-21 and 25 drawn to methods of preparing compounds of Structural Formula IIa, IIb or VII; and Group II for claims 22-24 and 26-30 drawn to methods of preparing compounds of Structural Formula I. Also, the Examiner restricted compounds within Markush groups of the claims.

Traversal With Respect to Groups I and II

Restriction among Groups I and II is improper because Applicants' invention of Group I (e.g., Claim 1) is generic to the invention of Group II. According to MPEP 809.02 quoting 37 CFR 1.146, restriction of a generic claim is improper unless the Examiner can show that the claims are directed to more than a reasonable number of species:

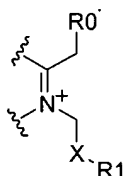
In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

For example, independent Claim 1 (Group I) is a generic claim which reads on Claims 22-24 and 26-30 of Group II. In particular, the claims of Group II recite the same reaction steps as Claim 1 and further recite reactions of a compound of Structural Formula IIa, IIb or VII to form a compound of Structural Formula I: Claims 22-24, 26-29 and 30 are indirectly dependent from independent Claims 1, 25 and 7, respectively (Group I); and Claim 1 is generic to Claims 7 and 25. Because Claim 1 is generic to the subject matter of Claims 22-24 and 26-30 of Group II, restriction of Groups I and II is only proper if the claims are directed to more than a reasonable number of species. However, because Group I is generic to Group II, the Examiner will necessarily be examining Group II when he is examining Group I. Therefore, it is clear that the

claimed subject matter is not directed to more than a reasonable number of species. Therefore, the restriction requirement of Groups I and II is improper.

Traversal With Respect to Markush Groups

The compounds recited in the claims of the application do not meet the requirements for the restriction of a Markush group, set forth by the Examiner. That is, the compounds recited in the claims of the application share a common utility, i.e., a cyclization reaction of a compound of Structural Formula IVa, and a common structural feature essential to the utility of the recited compounds. i.e., a structural moiety characterized by the structural formula blow:



Therefore, the restriction requirement is improper with respect to the Markush groups of the claims in view of *In re Weber*, 580 F. 2d 455, 198 USPQ 328 (CCPA 1978) (see MPEP 803.2).

Summation

In sum, Group I is generic to Group II. Also, the compounds included within the Markush groups of the claims of the application share a common utility, and share a substantial structural feature disclosed as being essential to the utility. Therefore, these restriction requirements are improper. Applicants respectfully request withdrawal of the restriction requirements.

If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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Dated: *January 4, 2006*